UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,563	06/05/2001	John Atcheson	REALNET.054C1C1	6917

20995 7590 03/22/2004

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER	
HAYES, JOHN W	

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/874,563	ATCHESON ET AL.
	Examiner	Art Unit
	John W Hayes	3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 December 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-38* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *1-7,10,12-14 and 36-38* is/are allowed.

6)☒ Claim(s) *8,9,11,15-18,22-28 and 31-35* is/are rejected.

7)☒ Claim(s) *19-21,29 and 30* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *05 June 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. Applicant has amended claims 1, 4-5, 7-11 and 14 and added new claims 15-38 in the amendment filed 22 December 2003. Thus, claims 1-38 remain pending and are presented for examination.

Terminal Disclaimer

2. The terminal disclaimer filed on 11 November 2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 5,583,763 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 9, 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per **Claim 9**, the terms "the database", "the input device" and "the output device" lack antecedent basis.

As per **Claim 11**, the term "the input device" lacks antecedent basis.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 15-20 and 22-24 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 15-20 and 22-24 only recite an abstract idea. The recited steps of merely generating a data structure, identifying a first set of objects, accessing the data structure, generating and providing a combined set of objects do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to identify and provide sets of objects.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, none of the recited steps are directed to anything in the technological arts as explained above with the exception of the recitation in the preamble that the method is carried out in a "multi-user computer system". Looking at the claim as a whole, nothing the body of the claim recites any structure or functionality to suggest that a computer performs the recited steps. Therefore, the preamble is taken to merely recite a field of use.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result . An invention, which is eligible or patenting under 35 U.S.C. 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine

whether the claimed invention produces a "use, concrete and tangible result". The test for practical application as applied by the examiner involves the determination of the following factors"

(a) "Useful" – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will note that:

i. the utility need not be expressly recited in the claims, rather it may be inferred.

ii. if the utility is not asserted in the written description, then it must be well established.

(b) "Tangible" – Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) "Concrete" – Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

In the present case, the claimed invention generates a combined set of objects (i.e., repeatable), and provides this combined set of objects (useful and tangible). Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 15-20 and 22-24 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Hey, U.S. Patent No. 4,996,642.

As per **Claim 8**, Hey discloses an apparatus for identifying preferences comprising:

a processor (Col. 3 line 63-Col. 4 line 2);

a database coupled to the processor (Col. 3 line 63-Col. 4 line 2);

means, coupled to the processor, for accepting signals to indicate first and second preferences (Col. 3 line 63-Col. 4 line 2);

means, coupled to the processor, for creating an association between the first and second preferences and for storing the first and second preferences in the database as a first datafile (Table 1, Col. 3 line 63-Col. 4 line 28; Col. 4, lines 63-68);

means, coupled to the processor, for accepting signals to indicate a user preference (Col. 3 line 63-Col. 4 line 2; Col. 4, lines 63-68);

means, coupled to the processor, for determining the degree that the user preference matches the first preference (Col. 3 line 63-Col. 4, line 2; Table 1);

means, coupled to the processor, for retrieving a correlated second preference from the database (Col. 4, lines 15-28; Col. 5, lines 2-10); and

an output device, coupled to the processor, for outputting the second preference (Col. 4, lines 15-28).

As per **Claims 15-16 and 25-26**, Hey discloses a method of recommending objects to a user comprising:

(a) generating a data structure which stores groupings of objects known to be of interest to a community of users (Table 1; Col. 3 line 63-Col. 4 line 2);

(b) identifying a first set of objects that are known to be of interest to a first user (Col. 3 line 63-Col. 4 line 2);

(c) accessing the data structure to identify one or more corresponding sets of objects containing similarities with the first set of objects (Col. 3 line 63-Col. 4 line 10);

(d) generating a combined set of objects from the identified one or more corresponding sets of objects (Col. 4, lines 15-21); and

(e) providing at least one of the combined set of objects generated in (d) (Col. 4, lines 15-21).

As per **Claims 17 and 27**, Hey further discloses wherein the database of objects comprises a plurality of digital audio selections (Col. 7, lines 6-12).

As per **Claims 18 and 28**, Hey further discloses wherein the first set of objects are identified based upon user input (Col. 3 line 63-Col. 4 line 2).

As per **Claims 22 and 31**, Hey discloses a method for generating a recommendation to a user for a media object from a plurality of media objects located in a media object database stored in a memory, the method comprising.

identifying a user profile indicating preferred media objects for the user (Table 1; Col. 3 line 63-Col. 4 line 2);

filtering the plurality of media objects located in the media object database into a filtered pool of media objects based upon the user profile and one or more stored profiles (Col. 4, lines 3-16);

determining a measure of relevance for the media objects in the filtered pool based upon at least the user profile and the one or more stored profiles (Col. 4, lines 3-16); and

recommending to the user, a media object selected from the filtered pool of media objects based at least in part upon the media object's measure of relevance (Col. 4, lines 16-28).

As per **Claims 23 and 32**, Hey further discloses wherein the plurality of media objects comprises a plurality of digital audio selections (Col. 7, lines 6-12).

As per **Claims 24 and 33**, Hey further discloses wherein the first set of objects are identified based upon user input (Col. 3 line 63-Col. 4 line 2).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hey, U.S. Patent No. 4,996,642.

As per **Claims 34-35**, Hey discloses wherein the user profile includes rating information for items that the user has sampled and further discloses that the items are identified by title (Table 1). Hey, however, fails to explicitly disclose wherein the user profile indicates an artist's name. Examiner submits, however, that it is well known that an object such as a movie or song would be identified by either the title or the artists name and it would have been obvious to one having ordinary skill in the art to identify the object using any known identifier. This would provide the benefit of identifying an object by any number of identifiers known to the user.

Allowable Subject Matter

11. Claims 1-7, 9-14 and 36-38 are allowable over the prior art of record.

12. Claims 19-21 and 29-30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Please address mail to be delivered by the United States Postal Service (USPS) as follows:

Mail Stop _____
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Please address mail to be delivered by other delivery services (Federal Express (Fed Ex), UPS, DHL, Laser, Action, Purolator, etc.) as follows:

U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window, Mail Stop _____
Crystal Plaza Two, Lobby, Room 1B03
Arlington, Virginia 22202

or faxed to:

(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-5531 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

John W. Hayes
Primary Examiner
Art Unit 3621

March 16, 2004